

Remarks/Arguments

The present amendment cancels claims 10, 11, 18-20, 29, 30, 37, 39, 70-76, 88, 98, 99, and 105 without prejudice to future prosecution. The cancelled claims were previously withdrawn from prosecution.

The pending claims currently stand rejected as follows:

- 1) Claims 78-84 stand rejected as allegedly failing to comply with the written description requirement; and
- 2) Claims 12, 31, 45-69 and 71-87 stand rejected as allegedly obvious based on U.S. Patent No. 6,720,139.

The previous office action indicated that the written description rejection was removed from claims 31, 45-69 and 77 based on these claims not reciting antisense nucleic acid with varying degrees of sequence identity to SEQ ID NO: 1463.

Independent claim 31 indicates providing antisense nucleic acid complementary to at least a portion of the nucleic acid encoding a gene product to reduce the activity or amount of the gene product. The gene product is further described in claim 31. Claims 78-84 depend from claim 31 and more particularly describe the antisense nucleic acid by reference to an indicated percentage of identity to SEQ ID NO: 1463.

35 U.S.C. § 112 (Written Description)

Claims 78-84 stand rejected for allegedly failing to comply with the written description requirement. Claims 78-83 indicate an antisense nucleic acid having at least 97%, 95%, 90%, 85%, 80%, 70% sequence identity to SEQ ID NO: 1463; and claim 84 indicates an antisense nucleic acid having at 70% identity to at least 100 consecutive nucleotide of SEQ ID NO: 1463. The examiner argues that the “mere recitation” of a sought for property of a nucleic acid cannot substitute for a description of the nucleic acid structure and argues that the specification does not provide guidance as to which of the “astronomical number of embodiments” embraced by the claims might have the functional properties of the claims. The rejection is respectfully traversed.

Claims 78-84 do not merely recite a sought for property. Rather, the claims also provide a generic structural description of antisense oligonucleotides based on SEQ ID NO: 14634.

Claims 78-84 vary in the indicated identity relationship to SEQ ID NO: 14634 from at least 70% to at least 97% identity. Reference to antisense activity provides a functional description that further limits the overall provided structure of the nucleic acid.

The rejection argues that the described group provides a large number of species. However, the rejection fails to provide evidence as to why oligonucleotides in general having the percent identity indicated in the claims would not have the functional property of an antisense oligonucleotide described in the claim. The Patent Office bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker* 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Based on the present application, it would not take undue experimentation to test antisense sequences within the claims. As noted above, important structural and functional descriptions are provided. The skilled artisan need only perform routine testing of sequences within the overall structure indicated in the claims (e.g., sequences of at least 70% identity) to confirm that such sequences have the desired antisense activity.

Double Patenting

Claims 12, 31, 45-69, 71-87, 89-96, 100, 101, 103 and 104 stand rejected based on obviousness-type double patenting in view of claims 1-6, 9 and 10 of U.S. Patent No. 6,720,139 (the '139 patent). The rejection argues that the species of the instant application anticipates the genus claimed in the '139 patent and therefore the methods claimed in the '139 patent embrace the methods as instantly claimed. The rejection is respectfully traversed.

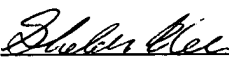
Whether the '139 patent embraces the methods as instantly claimed, or the present application anticipates the '139 patent, does not establish obviousness-type double patenting for the present claims. Domination by itself does not give rise to double patenting. *In re Kaplan*, 229 USPQ 678, 681 (Fed. Cir. 1986); see also Manual of Patent Examining Procedure Rev. 3, August 2005, at page 800-19, second column, first paragraph. In addition, "[t]he fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render the claimed compound obvious." *In re Baird* 29 USPQ2d 1550, 1552 (Fed. Cir. 1994), citing to *In re Jones* 21 USPQ2d 1941, 1943 (Fed. Cir. 1992).

An obviousness-type double patenting analysis generally involves: (1) determining the differences between the claims in the earlier patent and the claims in the later patent; and (2) determining whether the differences renders the claims patentable distinct. *Eli Lilly and Co. v. Barr Laboratories Inc.*, 58 USPQ2d 1869, 1878 (Fed. Cir. 2001).

The pending claims differ from the '139 patent claims by providing descriptions of sequences. The rejection fails to indicate where the '139 patent claims specially provide such sequences.

Accordingly the claims are in condition for allowance. Please charge deposit account 13-2755 for fees due in connection with this amendment. If any time extensions are needed for the timely filing of the present amendment, applicants petition for such extensions and authorize the charging of deposit account 13-2755 for the appropriate fees.

Respectfully submitted,

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